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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/664,560

09/17/2003

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27752 7590 03/17/2011
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EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1798

MAIL DATE

DELIVERY MODE

03/17/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/664,560
Filing Date: September 17, 2003
Appellant(s): DEASON ET AL.

Christian M. Best
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 20, 2010 appealing from the Office action mailed August 5, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
1-2, 10-12 and 14-15.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUND(S) OF REJECTION

Claims 1-2, 10-12, and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartbauer et al., 3,960,272 and 3,912,571 (referred to collectively as Hartbauer)

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

3,960,272	HARTBAUER et al.	06-1976
3,912,571	HARTBAUER et al.	10-1975
6,924,042 B2	VON PALESKE	08-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 10-11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartbauer et al., 3,360,272 and 3,912,571 (referred to collectively as Hartbauer).

The examiner has interpreted the consumer accessible tab of Hartbauer as being the overlapping portion and fold. See components “306” and “308” of Figure 12 and “304”, “306” and “308” of Figure 13.

Regarding claim 1, Hartbauer teaches a rolled multi-ply product of the type contemplated by applicants, comprising a rolled multi-ply fibrous structure having a core end and a tail which is bound to another portion of the multi-ply product by an adhesive, wherein the tail of the multi-ply fibrous structure comprises a consumer accessible tab, as required by claim 1. See ‘272 and ‘571, Figures 11-15 and claim 17. In particular, components “306” and “308” of Figure 12 and “304”, “306” and “308” of Figure 13. As to the requirement that at least a portion of the consumer accessible tab that is accessible to a consumer is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue, Figure 12 discloses a portion of the overlapping fold “306” which is located between the tail end and the tail seal glue “310”. Figure 13 discloses tail seal glue that does not appear to extend downward to the tail end. A portion of the overlapping fold “304” and tail segments “306” and “308” of Figure 13, which encompass the consumer accessible tab appear to be located between the tail end and tail seal glue. Accordingly, the disclosure in Figures 12 and 13 anticipate the requirement that at least a portion of the consumer accessible tab is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue.

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Regarding claim 2, Hartbauer teaches that the multi-ply fibrous structure is freely convolutedly wound from the core end out to the tail end to form a rolled multi-ply product. See '272, column 2, lines 61-66 and '571, column 2, lines 60-65.

Regarding claims 10-11, the consumer accessible tab of Hartbauer extends from about the tail end of the fibrous structure along the fibrous structure towards the core end of the multi-ply fibrous structure. Note Figures 12 and 13.

Regarding claim 15, Hartbauer teaches that the multi-ply fibrous structure can be a sanitary tissue product. See '272 column 12, line 50 and '571, column 12, and line 52.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 10-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartbauer et al., 3,360,272 and 3,912,571 (referred to collectively as Hartbauer).

For clarification purposes, the examiner has interpreted the consumer accessible tab of Hartbauer as being the overlapping portion and fold. See components "306" and "308" of Figure 12 and "304", "306" and "308" of Figure 13.

Regarding claim 1, Hartbauer teaches a rolled multi-ply product of the type contemplated by applicants, comprising a rolled multi-ply fibrous structure having a core end and a tail which is bound to another portion of the multi-ply product by an adhesive,

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wherein the tail of the multi-ply fibrous structure comprises a consumer accessible tab, as required by claim 1. See '272 and '571, Figures 11-15 and claim 17. In particular, components "306" and "308" of Figure 12 and "304", "306" and "308" of Figure 13. As to the requirement that at least a portion of the consumer accessible tab that is accessible to a consumer is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue, Figure 12 discloses a portion of the overlapping fold "306" which is located between the tail end and the tail seal glue "310". Figure 13 discloses tail seal glue that does not appear to extend downward to the tail end. A portion of the overlapping fold "304" and tail segments "306" and "308" of Figure 13, which encompass the consumer accessible tab appear to be located between the tail end and tail seal glue. This teaching renders obvious the requirement of present claim 1. Moreover, it is the examiner's position that the change in location of the consumer accessible tab, wherein said location is within the same general location as the prior art consumer accessible tab and performs the same function as the prior art consumer accessible tab constitutes no more than an unpatentable rearrangement of parts. See MPEP 2144.04.

Regarding claims 2 and 14, Hartbauer teaches that the multi-ply fibrous structure is freely convolutedly wound from the core end out to the tail end to form a rolled multi-ply product. The teachings of multi-ply would render obvious at least two plies bonded together.

Regarding claims 10-11, the consumer accessible tab of Hartbauer extends from about the tail end of the fibrous structure along the fibrous structure towards the core end of the multi-ply fibrous structure.

Regarding claim 12, Hartbauer specifically teaches that his fibrous structure can be a multi-ply fibrous structure. Accordingly, the examiner has reason to believe that the at least two plies of the multi-ply fibrous structure are bonded together by mechanical and/or chemical and/or electrostatic forces in the absence of factual evidence to the contrary.

As to claim 15, Hartbauer teaches that the multi-ply fibrous structure can be a sanitary tissue product. See '272 column 12, line 50 and '571, column 12, and line 52.

Accordingly the teaching of Hartbauer would have rendered obvious the invention as claimed in present claims 1-2, 10-12 and 14-15.

Claims 1-2, 10-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartbauer et al., 3,960,272 and 3,912,571 (Hartbauer) as applied above, and further in view of Von Paleske 6,924,042 B2.

Hartbauer is as set forth above and teaches a rolled multi-ply fibrous product of the type contemplated by applicants. Von Paleske teaches that it is known in the art to form multi-ply products wherein at least two of the plies are bonded together. See abstract and column 2, lines 25-63. Therefore, it would have been obvious to one of ordinary skill in this art, at the time the invention was made to use as the multi-ply fibrous product of Hartbauer, a multi-ply fibrous product of the type taught by Von

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Paleske and as known in this art, namely, a multi-ply fibrous product wherein the first ply and second ply are bonded together.

Therefore, the combine teachings of Hartbauer and Von Paleske would have rendered obvious the invention as claimed in present claims 1-2, 10-12, and 14-15.

(10) Response to Argument

Appellants argue that neither Hartbauer itself, nor in view of Von Paleske discloses, teaches and/or suggests all elements of claim 1 and more specifically, neither discloses, teaches and/or suggests “a portion of the consumer accessible tab that is accessible to a consumer is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue, as recited in claim 1.

The examiner disagrees. In particular, as set forth above, the examiner has interpreted the tab of Hartbauer as being the overlapping portion “306” and the fold “308” of Figure 12 and the overlapping portion “304” and fold “306” and “308” of Figure 13. The referenced Figures 12 and 13 clearly shows "at least a portion" of the tab of Hartbauer positioned between the tail end and the tail seal glue. Appellants' claims do not require that the entirety of that segment that constitutes the consumer accessible tab be located between the tail end and the tail seal glue, only that “at least a portion” be positioned accordingly.

Appellants argue that the statements on pages 3 and 4 of the Final Rejection do not answer the question of “why” a person of ordinary skill in the art would be motivated to modify Hartbauer to arrive at the claimed invention and/or combine Hartbauer with

Von Paleske to arrive at the claimed invention. Appellants further argue that the examiner has used hindsight in view of the Appellants' disclosure.

In response thereto, it is the examiner's position that the consumer accessible tab includes an overlapping portion that is located between the tail seal glue and tail end. See Figure 12, which identifies "306" and "308" as the fold, wherein a portion of the fold is located between the tail seal glue and tail end. Note also the overlapping fold "304" and tail segments "306" and "308" of Figure 13. Additionally, Figure 13 appears to show tail seal glue that does not extend to the tail ends and would result in at least a portion of the tab being between the tail seal glue and the tail end. The showings in Figures 12 and 13 anticipate this requirement of present claim 1. Furthermore, it is the examiner's position that a rolled multi-ply product comprising a core end and a tail that is bound to the multi-ply product by tail seal glue, wherein the tail comprises a tail end and consumer accessible tab is clearly disclosed by the prior art. Appellants' requirement that at least a portion of the consumer accessible tab is positioned between the tail end and the tail seal glue is drawn to the location of the tab and the tail seal glue. In view of Figures 12 and 13 of the prior art, this requirement constitutes an unpatentable rearrangement of parts (tail seal glue and/or fold). It is the examiner's position that the change in location of the consumer accessible tab, wherein said location is within the same general location as the prior art consumer accessible tab and performs the same function as the prior art consumer accessible tab constitutes no more than an unpatentable rearrangement of parts. It would have been obvious to one having ordinary skill in the art to adjust the location of the adhesive higher on the roll to

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the location where the fold meets the underlying roll (away from the free tail end) to aid in quick separation of the tab from the underlying roll with short tears. This rearrangement would result in at least a portion of the tab being between the tail seal glue and the tail end. See MPEP 2144.04. As to the teachings of Von Paleske, his teachings would have provided direction to the skilled artisan at the time the invention was made to modify the teachings of Hartbauer by forming his multi-ply products using at least two plies bonded together. See abstract and column 2, lines 25-63. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellants argue that Hartbauer teaches away from the present invention because Hartbauer teaches folding the tail portion of the tissue back over an adjacent portion of the tissue and Appellants' invention eliminates the requirement that a fold be made in the tissue, further arguing that Hartbauer expressly teaches that "the free end of the tail portion is spaced from a wound portion of the roll product."

The examiner disagrees. Appellants' claim 1 does not exclude a fold in the consumer accessible tab. Also, appellants have defined their "consumer accessible tab" as being "a part of the multi-ply fibrous structure near the tail end of the fibrous

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structure that is accessible to a consumer using a never-before-used (i.e., brand new) multi-ply product.” See page 3, lines 24-26. This definition does not exclude a fold in the tissue. Moreover, the disclosure of Hartbauer of a fold does not constitute a teaching away from the present invention because Hartbauer does not criticize, discredit or otherwise discourage a manually graspable element in the tail portion of the roll product that is releasably secured to an underlying convolution of the roll product by means of an adhesive. *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Appellants argue that the present application eliminates waste because the folded over portion of Hartbauer is not useful to the consumer and is likely wasted during use leading to the increased creation of waste, further arguing that the consumer accessible tab of the present invention allows a consumer to have full use of a first sheet of tissue, thereby reducing waste.

The examiner disagrees. Appellants’ argument appears to be based upon the presumption that the average consumer may only use a single sheet of a multi-ply product such as toilet tissue at a given time. Or that the consumer would be motivated to remove and discard the first sheet of a multi-ply product such as toilet tissue and then continue using the rest of the roll. There is no evidence on this record to support Appellants’ allegations of waste. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

Appellants argue that they disagree with the Final Rejection's position that the claimed invention is merely a rearrangement of parts of the prior art, further arguing that neither Hartbauer nor the Final Rejection provide a motivation or an apparent reason to rearrange its parts to arrive at the claimed invention of the Subject Application, per MPEP 2144.04, and that Hartbauer's fold cannot be properly rearranged to arrive at the claimed invention. Appellants also argue that there has been a long felt, unmet need for the claimed invention, even in the light of Hartbauer which has been in the art for over 35 years.

In this regard, it is the examiner's position that Hartbauer discloses that the adhesive is preferably in the form of dots ('272, column 12, lines 64-66), and Figure 13 appears to disclose that the adhesive is not extended completely to the tail end. It would have been obvious to one having ordinary skill in the art to adjust the location of the adhesive higher on the roll to the location where the fold meets the underlying roll (away from the free tail end) to aid in quick separation of the tab from the underlying roll with short tears. This rearrangement would result in at least a portion of the tab being between the tail seal glue and the tail end. As to Appellants argument that there has been a long felt, unmet need for the claimed invention, this is not persuasive because Appellants have provided no objective evidence that an art recognized problem existed in the art for a long period of time without solution. In particular, Appellants have not established that this need has been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967). Nor have Appellants established that this long felt need have not been satisfied

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by another before the invention by Appellants. *Newel Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988). Finally, Appellants have not factually established that the present invention satisfies this long-felt need. *In re Cavanagh*, 436, F.2d 491, 168 USPQ 466 (CCPA 1971). See MPEP 716.04.

Appellants argue that dependent claim 2 recites, in part, “the multi-ply fibrous structure is freely convolutedly wound from the core end out to the tail end to form the rolled multi-ply product” and that the tail end of Hartbauer is not “wound from the core end out to the tail end” but is folded under the sheet comprising the tail end of the roll.

In response thereto, it is noted that Appellants have defined “convolutedly wound” to mean that a material is rolled or folded together with on part over another in a non-bound manner. Note page 3, lines 27-29 of the specification. This definition would appear to embrace the fold of Hartbauer.

Appellants argue that dependent claim 10 recites in part, “the consumer accessible tab extends from the tail end of the multi-ply fibrous structure along the multi-ply fibrous structure towards the core end of the multi-ply fibrous structure” and that the tab of Hartbauer initially travels from the tail end in a direction opposite the core end, which is inconsistent with the claimed recitation of claim 10 of “the consumer accessible “tab” extends from the tail end...toward the core end” and that while it may be argued that a portion of the “tab” of Hartbauer may extend toward the core end, this portion, however, does not extend from the tail end.

The examiner disagrees. In particular, as set forth above, the examiner has interpreted the consumer accessible tab of Hartbauer as being the overlapping portion

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and fold. According to Figure 13, the fold extends from the direction of the tail end towards the core end of the multi-ply fibrous structure.

Appellants argue that a similar argument as set forth above applies to dependent claim 11.

In this regard, the examiner disagrees for the reasons stated above and incorporated herein.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

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rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Jill Gray/

Primary Examiner, Art Unit 1798

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Angela Ortiz, SPE AU 1798

/Angela Ortiz/

Supervisory Patent Examiner, Art Unit 1798

Art Unit: 1798

/ROBERT J. WARDEN, Sr./

Supervisory Patent Examiner, Art Unit 1700

Technology Center Designee